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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,851	06/07/2001	Motomu Koike	U 013213-2	7723

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05/01/2003

Ladas & Parry
26 West 61 Street
New York, NY 10023

EXAMINER

FORTUNA, JOSE A

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 05/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO. AS
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EXAMINER

ART UNIT	PAPER
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Commissioner for Patents

1. The timely submission under 37 CFR 1.129(a) filed on February 21, 2003 is not fully responsive to the prior Office action because there rejected claims were not addressed, see below. Since the submission appears to be a bona fide attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer, to submit a complete reply. This shortened statutory period supersedes the time period set in the prior Office action. This time period may be extended pursuant to 37 CFR 1.136(a). If a notice of appeal and the fee set forth in 37 CFR 1.17(e) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant is construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). The appeal stands dismissed.

2. The previous office action was a Supplemental action in which indicated that the rejection was based on the original claims. This was done, because in applicants' response of paper no. 6, applicants requested a new action since they could not identify a cited reference. The examiner reset the Short Statutory Period, without considering the amendment to the claims to give applicants time to review the non-identified reference and then submit or re-submit the amendment in view of the reading of the reference.


José A Fortuna
Primary Examiner
Art Unit: 1731

APPLICANTS MAY SUBMIT / AMENDMENTS TO SPECIFICATION, CLAIMS AND DRAWINGS IN THE REVISED AMENDMENT FORMAT

For amendments filed in Art Units 1626, 1634, 1731, 2827 and 2834

Starting in late April 2003, the United States Patent and Trademark Office (USPTO) will be processing patent applications in electronic image form in Art Units 1626 and 1731 in addition to the three original Art Units (1634, 2827 and 2834) in the "prototype program"¹. Applicants with applications in these art units are encouraged to use a revised amendment format for amendments to the claims, specification, and drawings, announced in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, 1267 Off. Gazette 106 (February 25, 2003), posted on the Office's web site at: <http://www.uspto.gov/web/offices/com/sol/og/2003/week08/patform.htm>. A summary of the revised amendment format is reproduced below.

The revised amendment format is essentially the same as the amendment format that the Office is proposing in a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. The Office plans to adopt such a revision to 37 CFR 1.121 by July of 2003², at which point compliance with revised 37 CFR 1.121 will become mandatory.

Effective immediately, when replying to Office actions in applications from Art Units 1626, 1634, 1731, 2827 and 2834 **all** applicants are encouraged to submit amendments using the revised amendment format (except for reissues and reexaminations), and which will be processed according to conditions specified herein.

REVISED FORMAT OF AMENDMENTS

Begin on separate sheets:

Each section of an Amendment (e.g., Claim Amendments, Specification Amendments, Remarks) should begin on a separate sheet. *For example*, in an amendment containing a.) introductory comments, b.) amendments to the claims, c.) amendments to the specification, and d.) remarks, each of these sections should begin on a separate sheet. This will facilitate the process of separately indexing and scanning of each part of an amendment document for placement in an electronic file wrapper.

Two versions of amended part(s) no longer required:

The current requirement in 37 CFR 1.121(b) and (c) to provide two versions (a clean version and a marked up version) of each replacement paragraph, section, or claim will be waived where an amendment is submitted in the revised format below. The requirements for substitute specifications under 37 CFR 1.125 will be retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, or submission of a new claim, must include a complete listing of all claims in the application. After each claim number, the status must be indicated in a parenthetical expression, and the text of each claim under examination (with markings to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number and identified by one of the following: (original), (currently amended), (previously amended), (canceled), (withdrawn), (new), (previously added), (reinstated – formerly claim # _), (previously reinstated), (re-presented – formerly dependent claim # _), or (previously re-presented). The text of all pending claims under examination must be submitted each time any claim is amended. Canceled and withdrawn claims should be indicated by only the claim number and status.
- (2) All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim should be shown by strikethrough (for

¹ See *USPTO ANNOUNCES PROTOTYPE OF IMAGE PROCESSING*, 1265 Off. Gaz. Pat. Office 87 (December 17, 2002)). The amendment practice of the Notice only provided for a waiver of 37 CFR 1.121(c), with respect to amendments to the claims. This flyer supercedes any previously received notification and now encourages the presentation of amendments in an expanded format, which applies to the amendment of specifications, drawings and claims.

² See *Changes To Implement Electronic Maintenance of Official Patent Application Records*, 68 Fed. Reg. 14365, (March 25, 2003).

- deleted matter) or underlined (for added matter). An accompanying clean version is not required and should not be presented. Only claims with the status "currently amended" will include markings.
- (3) The text of pending claims not being amended must be presented in each amendment document in clean version, i.e., without any markings. Any claim presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version.
 - (4) A claim may be canceled by merely providing an instruction to cancel. Listing a claim as canceled will constitute an instruction to cancel. Any claims added by amendment must be indicated as (new) and shall not be underlined.
 - (5) All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or withdrawn claims may be aggregated into one statement (e.g. Claims 1 – 5 (canceled)).

Example of Listing of Claims:

Claims 1-5 (canceled)

Claim 6 (withdrawn)

Claim 7 (previously amended): A bucket with a handle.

Claim 8 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 9 (withdrawn)

Claim 10 (original): A bucket with a wooden handle.

Claim 11 (canceled)

Claim 12 (re-presented – formerly dependent claim 11): A black bucket with a wooden handle.

Claim 13 (previously added): A bucket having a circumferential upper lip.

Claim 14 (new): A bucket with plastic sides and bottom.

B) Amendments to the Specification:

Amendments to the specification must be made by presenting a replacement paragraph or section marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per current 37 CFR 1.125.

C) Amendments to the drawings:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with § 1.84. An explanation of the changes made must be presented in the remarks section of the amendment. Any replacement drawing sheet must include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing should **not** be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

COPIES OF U.S. PATENT DOCUMENTS CITED IN AN IDS OR OFFICE ACTION

In applications assigned to the five art units listed above, applicants and practitioners will no longer be required to provide copies of U.S. Patents and U.S. Patent Application Publications cited in any Information Disclosure Statement (IDS) submitted to the USPTO. It is requested that eIDSs be used to file all IDS papers for applications in the listed Art Units. Similarly, copies of U.S. Patents and U.S. Patent Application Publications cited by an examiner during prosecution of an application will not be provided to applicants in Office actions from these Art Units. These documents are available from the USPTO web site, www.uspto.gov, for free download. Cited foreign patents and published applications and non-patent literature will be mailed by conventional processing.

Any questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to Liz Dougherty (Elizabeth.Dougherty@uspto.gov), Eugenia Jones (Eugenia.Jones@uspto.gov) or Joe Narcavage (Joseph.Narcavage@uspto.gov). For information on the waiver or legal aspects of the program, please contact Jay Lucas (Jay.Lucas@uspto.gov) or Rob Clarke (Robert.Clarke@uspto.gov).